

Application Serial No.: 10/659,246

Amdt. dated March 29, 2007

Reply to Non-Final Office Action of November 29, 2006

### **REMARKS/ARGUMENTS**

The Office Action dated November 29, 2006 and the references cited therein have been carefully considered. In response to the Office Action, Applicants have canceled Claims 40-45, 47, 50, 67, 78-82 and 84-87, have amended Claims 48-49, 51-53, 55-56, 59, 65, 68-69 and 83 and have added new Claims 89-104 which, when considered with the remarks set forth below, are deemed to place the case in condition for allowance. As a result of the present Amendment, Claims 46, 48-49, 51-66, 68-77, 83 and 88-104 remain in the case for continued prosecution.

#### ***Information Disclosure Statement***

Applicants would first like to bring to the attention of the Examiner several references cited in a related application (U.S. Application Serial No. 09/913,906). Accordingly, Applicants submit herewith a Supplemental Information Disclosure Statement for the Examiner's consideration.

#### ***Independent Claim 46***

Independent Claim 46 has been allowed. In response, Applicants have canceled Claims 40-45, 47, 50, 67, 69-82 and 84-87 and have amended Claims 48-49, 51-53, 55-56, 59, 65, 68 and 83 to depend from allowed Claim 46. Applicants have also added new Claims 89 and 90, which also depend from allowed Claim 46. Accordingly, it is believed that Claims 46, 48-49, 51-66, 68, 83 and 89 and 90 are now in condition for allowance.

#### ***Independent Claim 69***

Claim 69 has been rejected under 35 U.S.C. §103(a) as being unpatentable over PCT Publication No. WO 97/20315 to Heiligers et al. in view of U.S. Patent No. 5,868,986 to Foulkes and U.S. Patent No. 6,255,948 to Wolpert et al. In sum, the Examiner states that the Heiligers reference discloses the claimed invention but fails to disclose an authentication

Application Serial No.: 10/659,246

Amdt. dated March 29, 2007

Reply to Non-Final Office Action of November 29, 2006

means in an injection molded part. The Examiner cites the Foulkes patent as disclosing an in mold labeling technique and the Wolpert patent as disclosing in mold labeling as an effective authenticating means. The Examiner concludes that it would have been obvious to combine these three references to arrive at the claimed invention.

In response, Applicants have amended independent Claim 69 to define a method for manufacturing a product comprising a compact disc (CD) or digital video disc (DVD) in a storage device, wherein the storage device has an authentication means comprising a printing. The method includes injection molding transparent plastic against or around the authentication means in a mold and loading the CD or DVD in the storage device, wherein the printing and the CD or DVD is visible through the first or second cover of the storage device. It is respectfully submitted that the prior art references, taken alone or combined, do not disclose these features.

The closest prior art cited by the Examiner is the Wolpert patent, which discloses in-mold labels carrying authentication means. However, there is absolutely no teaching or suggestion of providing such authentication means on CD or DVD boxes for authentication of the specific CD or DVD in such boxes.

Moreover, in the Wolpert patent, the indicia are provided by using at least one magnetic layer, which is not necessary in the present invention. Providing a simple, non-metallic in-mold label, printed with product specific information, renders the box relatively inexpensive and still suitable for authentication, whereas no magnetic properties are present close to the CD or DVD, which might influence the information and/or apparatus with which such data carrier is to be used.

In addition, amended Claim 69 defines a transparent CD or DVD box, such that the CD or DVD to be authenticated and the authentication printing can be seen through the box. Thus the present invention, as defined in Claim 69, is a very specific choice of features with a very specific aim, which is neither disclosed nor rendered obvious by the prior art. Accordingly, it is respectfully submitted that independent Claim 69 and Claims 70-77, which depend therefrom, patentably distinguish over the prior art.

Application Serial No.: 10/659,246  
Amdt. dated March 29, 2007  
Reply to Non-Final Office Action of November 29, 2006

***Independent Claim 88***

Claim 88 has been rejected under 35 U.S.C. § 103(a) as being unpatentable over PCT Publication No. WO 97/20315 to Heiligers et al. in view of U.S. Patent No. 5,868,986 to Foulkes and U.S. Patent No. 6,255,948 to Wolpert et al. Applicants respectfully traverse this rejection.

Independent Claim 88 defines a method for manufacturing a storage device for a compact disc (CD) or digital video disc (DVD) wherein authentication information unique to the individual CD or DVD is provided on the storage device. This authentication information is provided by positioning a printer head adjacent a surface of an injection mold used to mold the storage device and providing a transfer ink directly on the mold surface with the printer head, wherein the ink printing is transferred from the mold surface onto the plastic and is incorporated therein. It is respectfully submitted that none of the cited prior art references, taken alone or combined, disclose such a manufacturing method.

In rejecting Claim 88, the Examiner first states that the Applicant failed to challenge the Official Notice taken by the Examiner in the previous Office Action (February 14, 2006) with respect to Claim 88. Applicants respectfully disagree. In particular, in response to the February 14, 2006 Office Action, Applicants specifically argued that it would not have been obvious from the teaching of the Wolpert patent to have included a printer head adjacent to the surface of an injection mold. More particularly, Applicants expressly argued that Wolpert only discloses printing on labels, layers of labels and the like and does not provide any indication whatsoever for printing directly onto a mold surface for transferring an image onto a product that is injection molded in the mold. Thus, contrary to the Examiner's assertion, Applicants did in fact challenge the Examiner's Official Notice and, therefore, the Examiner's statements in the previous Office Action should not be taken to be admitted prior art.

The Examiner correctly notes that the combination of Heiligers, Foulkes and Wolpert do not expressly disclose the step of positioning a printer head adjacent a surface of an injection mold. However, the Examiner states that Wolpert discloses that graphic indicia can

Application Serial No.: 10/659,246

Amdt. dated March 29, 2007

Reply to Non-Final Office Action of November 29, 2006

be printed as line work or as halftone and can be accomplished using multiple print stations and, therefore, based further on Examiner's Official Notice, the Examiner concludes that it is well known in the art to position a printer head adjacent a surface of an injection mold for a better controlling of the printing on the mold surface and therefore a better printing quality.

Applicants respectfully submit that there is no basis for this conclusion. Specifically, none of the prior art references, including Wolpert, discloses printing on a mold surface at all and there is nothing in these references to support the assertion that it would have been obvious to do so. More particularly, while Heiligers discloses a CD storage box, Foulkes discloses in-mold labeling and Wolpert discloses integrally formed security devices, none of these references even remotely teaches or suggests providing authentication information with a transfer ink from a printer head positioned adjacent an injection mold.


Instead, the closest prior art (Wolpert), only discloses printing on labels, layers of labels and the like and does not provide any indication whatsoever for printing directly onto a mold surface with a transfer ink so that authentication information will later be transferred into the storage box upon injection molding of the storage box. Accordingly, it is respectfully submitted that independent Claim 88 and new Claims 91-104, which depend therefrom, patentably distinguish over the prior art.

Application Serial No.: 10/659,246  
Amdt. dated March 29, 2007  
Reply to Non-Final Office Action of November 29, 2006

***Conclusion***

In view of the foregoing amendment and remarks, favorable consideration and allowance of the application with Claims 46, 48-49, 51-66, 68-77, 83 and 88-104 are respectfully solicited. If the Examiner believes that a telephone interview would assist in moving the application toward allowance, he is respectfully invited to contact the Applicants' attorney at the telephone number listed below.

Respectfully submitted,



---

Steven T. Zuschlag  
Registration No.: 43,309  
Attorney for Applicants

HOFFMANN & BARON, LLP  
6900 Jericho Turnpike  
Syosset, New York 11791  
(516) 822-3550  
STZ/mf

235161\_1